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| APPLIED MATERIALS, INC.<br>P. O. BOX 450A<br>SANTA CLARA, CA 95052 |             |                      | TUROCY, DAVID P     |                  |
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The time period for reply, if any, is set in the attached communication.

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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*Ex parte* WON BANG,  
CHEN-AN CHEN,  
SHANKAR VENKATARAMAN, and  
AJAY BHATNAGAR

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Appeal 2007-0949  
Application 10/081,312  
Technology Center 1700

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Decided: January 31, 2008

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Before EDWARD C. KIMLIN, CHARLES F. WARREN and  
MICHAEL P. COLAIANNI, *Administrative Patent Judges*.

COLAIANNI, *Administrative Patent Judge*.

**DECISION ON REQUEST FOR REHEARING**

This is in response to a Request, filed August 31, 2007, for rehearing of our decision, mailed July 31, 2007, wherein we sustained the following rejections: (1) the § 103 rejection of claims 1-7, 10-12, 18, and 19 as being unpatentable over Toyoda in view of Ohashi, Itoh, Tomita and Morton; (2)

the § 103 rejection of claim 8 as being unpatentable over Toyoda in view of Ohashi, Itoh, Tomita, Morton and Kubota; (3) the § 103 rejection of claim 9 as being unpatentable over Toyoda in view of Ohashi, Itoh, Tomita, Morton and Ohmi; (4) the § 103 rejection of claims 14 and 15 as being unpatentable over Toyoda in view of Ohashi, Itoh, Tomita, Morton and Kawamata; (5) the § 103 rejection of claims 1, 3-6, 10, 11, 18 and 19 as being unpatentable over Tomita in view of Morton; (6) the § 103 rejection of claim 2 as being unpatentable over Tomita in view of Morton and Itoh; and (7) the § 103 rejection of claim 9 as being unpatentable over Tomita in view of Morton, Itoh and Ohmi.

Appellants indicate that the portion of the *KSR Int'l Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 1742 (2007) decision cited by the Board requires there to be a finite number of identified, predictable solutions which must lead to anticipated success (Request 1-2). Appellants argue that success could not have been anticipated in the references used by the Examiner in the § 103 rejections because “the solutions alleged by the Examiner and adopted by the Board are of the Examiner’s conclusion without factual underpinning by the cited references or established as known by one skilled in the art” (Request 2).

In the Decision, we cited to the portion of the *KSR* decision where the Court indicated that one of ordinary skill in the art, attempting to solve a problem, would not only be led to those pieces of prior art that attempt to solve the same problem (Decision 5 and 6). Specifically, in the portion of the *KSR* decision we cited, the Court stated that “[c]ommon sense teaches, however, that familiar items may have obvious uses beyond their primary

purposes, and in many cases a person of ordinary skill will be able to fit the teachings of multiple patents together like pieces of a puzzle.” *KSR*, 127 S. Ct. at 1742.

In contrast, the portion of the *KSR* decision cited by Appellants in the Request relates to the Court’s assessment of the “obvious to try” rationale (Request 1). Accordingly, Appellants’ “anticipated success” argument is misplaced because we did not rely on the “obvious to try” rationale in the Decision. Moreover, contrary to Appellants’ argument, for the reasons provided on pages 4-9 and 19-21 of the Answer and pages 5-16 of the Decision, the Examiner’s rejections are based on the disclosures of the references, not conclusory statements of the Examiner.

Appellants argue for first time in this appeal that Itoh’s sputtering deposition process and Toyoda’s electron beam deposition process operate under fundamentally different principles such that a disclosure regarding the process parameter in a sputtering deposition process would not predictably produce a result in an electron beam deposition process (Request 2). In accordance with 37 C.F.R. § 41.52, because such a new argument is not made regarding a “recent relevant decision of the Board or a Federal Court” or in response to a new grounds of rejection under § 41.50(b), Appellants’ newly advanced argument has not been considered.

Appellants rehash their argument that Tomita’s evaporative process differs from Morton’s physical vapor deposition (PVD) process such that the “Examiner[’]s opinion that a process parameters [*sic*, parameter] from an evaporative deposition process would produce a predic[t]able result [*sic*, in]

a PVD process can not support the asserted combination when made without support from the references or other extrinsic evidence" (Request 2).

Contrary to Appellants' argument, we indicated on page 13 of the Decision that evaporative processes are a type of physical deposition (Decision 13). For this reason, we adhere to our position that Appellants' argument is unpersuasive.

Appellants argue that Ohashi's teaching to avoid pin holes and defects does not suggest increasing the density of the coating and that such suggestion is merely the Examiner's opinion (Request 2). Appellants further argue that the Examiner concludes, without supporting evidence, that Toyoda's disclosure to use a highly pure magnesium fluoride target does not mean that the resulting magnesium fluoride coating is highly pure (Request 2-3). Both of these arguments are rehashed forms of Appellants' arguments that a high purity sputtering target and a pin-hole free coating do not necessarily imply a specific purity or density (Br. 5).

However, Appellants are improperly attacking the references individually when the combination is based on the teachings of the references taken as a whole. Nonobviousness cannot be established by attacking references individually where the rejection is based upon the teachings of a combination of references. *In re Merck & Co.*, 800 F.2d 1091, 1097 (Fed. Cir. 1986). As the Examiner and the Board noted, when the combination of Toyoda in view of Ohashi, Itoh, Tomita, and Morton's teachings are taken as whole, the claimed invention would have been obvious (i.e., the teachings fit together like "pieces of a puzzle" *KSR*, 127 S. Ct. at 1742) (Decision 5-16).

For the above stated reasons, we adhere to our conclusion that claims 1-12, 14, 15, 18, and 19 are unpatentable under the following rejections: (1) the § 103 rejection of claims 1-7, 10-12, 18, and 19 as being unpatentable over Toyoda in view of Ohashi, Itoh, Tomita and Morton; (2) the § 103 rejection of claim 8 as being unpatentable over Toyoda in view of Ohashi, Itoh, Tomita, Morton and Kubota; (3) the § 103 rejection of claim 9 as being unpatentable over Toyoda in view of Ohashi, Itoh, Tomita, Morton and Ohmi; (4) the § 103 rejection of claims 14 and 15 as being unpatentable over Toyoda in view of Ohashi, Itoh, Tomita, Morton and Kawamata; (5) the § 103 rejection of claims 1, 3-6, 10, 11, 18 and 19 as being unpatentable over Tomita in view of Morton; (6) the § 103 rejection of claim 2 as being unpatentable over Tomita in view of Morton and Itoh; and (7) the § 103 rejection of claim 9 as being unpatentable over Tomita in view of Morton, Itoh and Ohmi.

The Request for Rehearing is denied.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

DENIED

tf/clj

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